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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,693	10/30/2000	Michael L. Howard	1351 P	7042
21552	7590	01/13/2005		
MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101			EXAMINER PATEL, NITIN C	
			ART UNIT 2116	PAPER NUMBER

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,693

Applicant(s)

HOWARD ET AL.

Examiner

Nitin C. Patel

Art Unit

2116

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in responsive to RCE filed on October 18, 2004.
2. Claims 1 – 20 are pending.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 – 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 15 of U.S. Patent No. 6,728,804 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention including a portable electronic device that is reprogram able through a pager network, the device comprising an external communication port, a transceiver, a processor, and reprogrammable memory programmed with instructions to cause the device to provide an identification for electronic device to controller through pager network and receive new program code for enhancing communications.

5. Every elements of claim 1 including a portable electronic device that is reprogrammable through a pager network, the device including an external communication port, a transceiver, a processor, and reprogrammable memory programmed with instructions to cause the device to

Art Unit: 2116

provide an identification for electronic device to controller through pager network and receive new program code for enhancing communications in application is taught by a communication adapter of patent in patent claims 1, 7, and 8.

6. Element of claim 2 external communication port for electronically connecting the device serially to another electronic device is taught by claim 8 of patent.

7. A plastic snap-fit enclosure of claim 3 is inherently taught by communication adapter element in claim 1 of patent.

8. Processor, and memory elements of claim 3 are taught by patent claim 1.

9. Data transceiver element and its connection of claim 5 are taught by network communication hardware for communicating with the provider computer through the communication network of claim 1.

10. Every elements of claim 6 including a portable electronic device that is reprogrammable through a pager network, the device including a substantially closed housing, a data transceiver, an antenna, a single board computer with a processor, a communication port, and reprogrammable memory programmed with instructions to cause the device to provide an identification for electronic device to controller through pager network and receive new program code for enhancing communications in application is taught by a communication adapter of patent in claims 1, 7, and 8.

11. A plastic snap-fit enclosure of claim 7 is inherently taught by communication adapter element in claim 1 of patent.

12. The 16-bit microcontroller of claim 8 is taught by processor element of claims 1, and 8.

13. The 8-bit microcontroller of claim 9 is taught by processor element of claims 1, and 8.

Art Unit: 2116

14. Every elements of claim 10 including a portable electronic device that is reprogrammable through a pager network, the device including an external communication port, a data transceiver, a processor, and flash memory programmed with instructions to cause the device to provide an identification for electronic device to controller through pager network and receive new program code for enhancing communications in application is taught by a communication adapter of patent in patent claims 1, 7, and 8.

15. Element of claim 11 external communication port for electronically connecting the device serially to another electronic device is taught by claim 8 of patent.

16. A plastic snap-fit enclosure of claim 12 is inherently taught by communication adapter element in claim 1 of patent.

17. Processor, and memory elements of claim 13 are taught by patent claim 1.

18. Data transceiver element and its connection of claim 14 are taught by network communication hardware for communicating with the provider computer through the communication network of claim 1.

19. Every elements of claim 15 including a portable electronic device that is reprogrammable through a pager network, the device including a means for processing, means for communicating through external port, means for storing data, means for communicating with pager network, means for providing identification for electronic device to controller through pager network, means for causing the device to receive new program code from pager network to give the device new functionality in application is taught by a communication adapter of patent in claims 15, 1, and 8.

Art Unit: 2116

20. A plastic snap-fit enclosure of claim 16 is inherently taught by communication adapter element in claim 1 of patent.
21. Microcontroller for processing of claim 18 are taught by processor element of patent claim 1.
22. The 16-bit microcontroller of claim 19 is taught by processor element of claims 1, and 8.
23. The 8 bit microcontroller of claim 20 is taught by processor element of claims 1, and 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nitin C. Patel whose telephone number is 571-272-3675. The examiner can normally be reached on 7:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on 571-272-3670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nitin C. Patel
January 10, 2005


LYNNE H. BROWNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100